

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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 Assignee..... Hewlett-Packard Development Company, L.P.
 Group Art Unit 2142
 Examiner..... B. Ailes
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 Confirmation No..... 1660
 Title: Device Configuration Methods and Apparatus

REPLY BRIEF OF APPELLANT

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Appellants respectfully request reversal of the rejections for the reasons set forth herein and the Brief of Appellant.

Argument A

Appellants respectfully submit that positively-recited limitations of claims 1-36 are not taught by the prior art references taken alone or in combination and the Office has failed to establish a proper prima facie 103 rejection for at least this reason.

Independent claims 1, 8, 15, and 21 recite *downloading data including configuration data including user-specified information*. In the Office Action dated April 6, 2007 (hereinafter "Office Action") and from which Appellants filed this appeal, the Office relies upon the teachings of col. 15, lines 33-39 of Kageyama as

S/N: 09/976,630
 PDNO. 10007585-1
 Reply Brief

allegedly teaching the above-recited limitations. As noted in the Brief of Appellants (hereinafter "Brief"), Appellants submitted that the teachings of col. 15 of Kageyama merely recite that a manufacturer may provide updated programs by the network for improved printing performance or adding or changing a print function of a printer per col. 13, lines 57+ of Kageyama and the teachings of col. 15 are *void of disclosing or suggesting downloading data including configuration data including user-specified information*.

In the Examiner's Answer at pages 17-18, the Examiner relies upon the teachings of col.5, line 66+ and Fig. 10 in support of the position that Kageyama teaches the claimed downloading. However, Appellants refer to col. 4, line 56 of Kageyama which provides that Fig. 10 is a printer information DB part and as clear from the teachings of col. 5, lines 56+ of Kageyama, the database 2121 and *information contained therein is resident in the printer 2100 itself. The Office has failed to point to any teachings that any of the contents of the database are downloaded*. In addition, the Office has failed to point to any teachings that any of the data of the *database is user-specified*. Further, the Office has failed to provide any teachings that the downloading of the updated programs at col. 15, lines 30+ includes downloading of any of the information of the database 2121.

Appellants respectfully submit that the Kageyama teachings relied upon by the Office fail to teach or suggest the positively-recited limitations of *downloading data including configuration data including user-specified information*. Appellants have failed to uncover any teachings in Kageyama of the above-recited limitations.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejections of the claims for at least this reason and the reasons set forth in the Brief.

Argument B

Independent claims 1, 8 and 21 recite *downloading data including a configuration plug-in including user-specified information*. The Office notes that Kageyama is void of teaching the claimed configuration plug-in. The Office relies upon the teachings of Engel as curing the deficiencies of Kageyama and states that the applet of Engel teaches the claimed configuration plug-in. Appellants

respectfully submitted in the Brief, that the combination of references relied upon in support of the rejection fail to teach or suggest the *downloaded configuration plug-in includes user-specified information* as claimed. Appellants disagree with the characterization of Appellants' arguments at pages 18-19 of the Examiner's Answer that Appellants argues that the applet of Engel includes user-specified information, and to the contrary, Appellants position is clearly stated that the applet of Engel fails to include user-specified information *which fails to teach or suggest the claimed limitations of downloading data including a configuration plug-in including user-specified information.*

The Examiner notes at page 19 of the Examiner's Answer that Engel is not relied upon as teaching user-specified information and states that the teachings of col. 5, lines 66+ of Kageyama are relied upon as teaching the user-specified information. As mentioned above, the Office has failed to identify any teachings that the contents of the database of the printer per col. 5, lines 66+ of Kageyama are downloaded or are user-specified. However, for sake of argument, even if the database information is considered to be downloaded, Appellants respectfully submit that such does not suggest *downloading a configuration plug-in including user-specified information* since none of the prior art references taken alone or in combination teach or suggest downloading a configuration plug-in including user specified information.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument C

Referring to the rejection of claims 1-36 over the combination of Kageyama and Engel, MPEP 2142 states that the concept of prima facie obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.* MPEP §2142 (8th ed., rev. 6). The Supreme Court has stated that some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness is needed. *KSR*

Int'l v. Teleflex, Inc., 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007). MPEP 2142 (8th ed., rev. 6) further provides that rejections on obviousness *cannot be sustained with mere conclusory statements*; instead there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness and which must be *factually supported* per MPEP 2142.

The teachings of Engel relied upon by the Office for reducing cost as alleged rationale for combining the references refer to arrangements for reducing cost with respect to *installing network devices on a network* to implement communications on the network per paragraphs 0005+ of Engle. Paragraphs 0007-0008 provide that the applet has cost savings compared with installation arrangements which use specialized application programs. Accordingly, Appellants respectfully submit that the cost saving teachings of Engel are with respect to applets providing cost improvements over arrangements which use specialized application programs to install network devices upon a network. *Appellants have failed to uncover any teachings in Kageyama that the arrangements of Kageyama use specialized application programs to install networked devices to which the Engel solution of use of an applet would be applicable to save cost.* Appellants respectfully submit that there is no rational underpinning to modify the arrangement of Kageyama per the teachings of Engel exists when Engel has not been demonstrated to be applicable to the embodiments of Kageyama, let alone provide any cost benefits with respect to the already disclosed disparate arrangements of Kageyama.

Appellants respectfully submit the Office has failed to provide a proper articulated reasoning with a rational underpinning in support of the 103 rejection. Appellants respectfully request reversal of the rejections of claims 1-36 for at least this reason and the reasons set forth in the Brief.

Argument D

Appellants respectfully submit that positively-recited limitations of the claims 2 and 7 are not disclosed by the teachings of Kageyama and Engel and the rejection is improper for at least this reason.

Appellants note that the Examiner's Answer recites the same database 2121 teachings of cols. 5 and 6 of Kageyama as relied upon in support of the rejection in the Office Action. Appellants respectfully submit that these teachings are void of

disclosing the claimed limitations especially when considered in combination with claim 1 from which they depend. In particular, claim 1 recites downloading a configuration plug-in and configuration data and claims 2 and 7 individually define that the *configuration plug-in and configuration data include data prepared by: determining a make and model for the hard copy output engine; and determining user thresholds for consumables associated with the hard copy output engine.*

The Office at page 18 of the Answer relies upon the teachings of col. 15 of Kageyama (referring to a manufacturer communicating updated programs and data, for example, for improving printing performance per col. 13, lines 57+ of Kageyama) as disclosing the claimed downloading limitations. However, the updating teachings of col. 15 of Kageyama are not disclosed as being applicable to the information stored in the database 2121 of the printer which is relied upon as teaching the user-specified information which is downloaded. Appellants respectfully submit that the teachings of the database 2121 internal of the printer may not be fairly relied upon to teach the above-recited limitations of claims 2 and 7 when such are properly read in combination with the *downloading* limitations of claim 1 from which they depend. In addition, the art is void of teaching that the updating teachings of col. 15, lines 32+ or the applet of Engel include data prepared by determining a make and model for the hard copy output engine; and determining user thresholds for consumables associated with the hard copy output engine. The prior art is void of teaching *downloading the configuration plug-in and configuration data which were prepared by the determinings* of claims 2 and 7. Appellants respectfully submit that these positively-recited limitations are not disclosed by the prior art references taken alone or in combination and the rejection is improper for at least this reason.

The Office also relies upon inherency in support of the rejection. The Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 6). The Office has recited no relationship to the database teachings of part 2121 of cols. 5 and 6 of Kageyama with the updating teachings of col. 15 of Kageyama. Appellants respectfully submit that combination of limitations reciting downloading the configuration plug-in and

configuration data which include data prepared by determining a make and model for the hard copy output engine, and determining user thresholds for consumables associated with the hard copy output engine have not been demonstrated to necessarily flow from the teachings of the prior art and may not be considered to be inherent. Appellants respectfully submit that the rejections are in error for at least this reason.

The Office at page 21 of the Examiner's Answer recites the teachings of col. 5, line 66 to col. 6, line 11 as teaching the limitations of *determining user thresholds for consumables associated with the hard copy output engine*. However, these teachings are void of any reference to a threshold. *Appellants have electronically searched both Kageyama and Engel and have failed to locate any reference to "threshold."* The Office has failed to provide any explanation as to how the presence of use information or operation information within a database may be fairly considered to teach the positively-claimed limitations which recite determining user thresholds. Use information or operation information may be stored without use of a threshold. The *determining user thresholds* limitations are not disclosed nor suggested by the prior art and the rejection is in error for at least this reason.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument E

Claims 9, 14, 16, 20, 22 and 27 recite *determining user thresholds for consumables associated with the hard copy output engine*. In the Examiner's Answer, the Office relies upon the same teachings of col. 5, line 66 – col. 6, line 11 of Kageyama in support of the rejection as were relied upon in the Office Action. These teachings are void of any reference to a threshold. *Appellants have electronically searched both Kageyama and Engel and have failed to locate any reference to "threshold."* Appellants respectfully submit the rejection is in error for at least this reason.

In addition, the Office has failed to provide any explanation as to how the presence of use information or operation information within a database and void of any reference to a threshold may be fairly considered to teach the positively-claimed limitations which recite determining user thresholds. Use information or operation information may be stored without use of a threshold.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument F

Claims 5, 12, 17 and 25 recite configuring the hard copy output engine using the downloaded data to set a **threshold** *for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed*. At page 22 of the Examiner's Answer, the Office recites the teachings of col. 6, line 5+ of Kageyama as allegedly teaching the above-recited limitations. These teachings merely state that various components of the printer are managed as consumable articles or replaceable parts. *The generic teachings of col. 6 relied upon by the Office fail to refer to a threshold, setting a threshold or that the downloaded data is used to set a threshold* as explicitly claimed. Appellants respectfully submit that the above-recited limitations are not disclosed by the prior art even if the teachings of Engel are combined with the teachings of Kageyama and the rejection is improper for at least this reason.

Appellants have electronically searched Kageyama and Engel and have failed to uncover any teachings therein with respect to a threshold. Appellants respectfully submit the rejection is in error for at least this reason.

The Office at page 22 of the Examiner's Answer states that Kageyama teaches management by way of monitoring use information where a user's device is monitored with respect to use information. Appellants respectfully disagree with the interpretation of the Kageyama teachings and reiterate that the teachings of col. 6, lines 5-11 merely teach that components may be managed as consumable articles or replaceable parts and fail to disclose any teachings with respect to a

threshold, setting a threshold or that the downloaded data is used to set a threshold as explicitly claimed. Appellants have also failed to uncover any monitoring teachings in cols. 5-6 where a user's device is monitored with respect to use information as alleged by the Examiner at page 22.

In addition, the Office relies upon the update teachings of col. 15 of Kageyama as teaching the claimed downloading limitations. Appellants have failed to uncover any teachings in Kageyama that any of the information of the database part 2121 of cols. 5-6 of Kageyama was obtained by the update teachings of col. 15 of Kageyama to be fairly considered to be downloaded data.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument G

Claim 28 recites wherein the downloading comprising downloading a value, and the configuring comprises **setting a threshold for a consumable associated with the hard copy output engine using the value.**

At page 22 of the Examiner's Answer, the Office now relies upon the database teachings of cols 5 and 6 of Kageyama as well as col. 6, lines 5-17 in support of the rejection. Appellants respectfully submit that these teachings of cols. 5 and 6 fail to disclose or suggest the above-recited limitations.

Appellants have electronically searched failed to uncover any teachings in Kageyama or Engel of a threshold let alone setting a threshold or setting the threshold using a downloaded value. Appellants respectfully submit the rejection is in error for at least this reason.

Appellants have failed to uncover any teachings of setting a threshold using a value that has been downloaded. Appellants respectfully submit the presence of use and operation information within a database of cols. 5 and 6 and generic teachings of management of parts as consumable articles or replaceable parts and generic management of printing status of col. 6 *may not be fairly considered to teach or suggest the claimed limitations of a threshold, setting a threshold or*

setting a threshold using a value which has been downloaded. Kageyama is void of any reference to “threshold” or setting a threshold for a consumable.

Appellants have also failed to uncover any monitoring teachings in cols. 5-6 where a user’s device is monitored with respect to use information as alleged by the Examiner at page 22.

The Office relies upon the update teachings of col. 15 of Kageyama as teaching the claimed downloading limitations. Appellants have failed to uncover any teachings in Kageyama that any of the information of the teachings of cols. 5-6 of Kageyama was obtained by the update teachings of col. 15 of Kageyama to be fairly considered to disclose the claimed limitations reciting downloading.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument H

Claims 29 and 30 recite *wherein the downloading comprising downloading a threshold for replenishment of a consumable associated with the hard copy output engine.*

The Office now relies upon the database teachings of cols. 5 and 6 of Kageyama as well as col. 6, lines 5-17 in support of the rejection. Appellants respectfully submit that these teachings of cols. 5 and 6 fail to disclose or suggest the above-recited limitations.

Appellants have electronically searched failed to uncover any teachings in Kageyama or Engel of a threshold. Appellants respectfully submit the rejection is in error for at least this reason.

Appellants have also failed to uncover any teachings of downloading a threshold for replenishment of a consumable as positively claimed. Appellants respectfully submit the storage of use and operation information within a database of cols. 5 and 6 and generic teachings of management of parts as consumable articles or replaceable parts and generic management of printing status of col. 6 *may not be fairly considered to teach or suggest the claimed limitations of a threshold let alone downloading a threshold for replenishment of a consumable as*

claimed. Kageyama is void of any reference to “threshold” or a threshold for replenishment of a consumable.

The Office relies upon the update teachings of col. 15 of Kageyama as teaching the claimed downloading limitations. Appellants have failed to uncover any teachings in Kageyama that any of the information of the teachings of cols. 5-6 of Kageyama was obtained by the update teachings of col. 15 of Kageyama to be fairly considered to disclose the claimed limitations reciting downloading.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument I

Claim 30 recites *that the configuring of claim 1 using the downloaded data comprises setting the threshold for replenishment of a consumable associated with the hard copy output engine.*

The Office now relies upon the database teachings of cols. 5 and 6 of Kageyama as well as col. 6, lines 5-17 in support of the rejection. Appellants respectfully submit the rejection is in error.

Appellants have electronically searched failed to uncover any teachings in Kageyama or Engel of a threshold. Appellants respectfully submit the rejection is in error for at least this reason.

The art is void of teaching or suggesting setting a threshold for replenishment of a consumable or that the threshold which was set was downloaded. The storage of use and operation information within a database of cols. 5 and 6 and generic teachings of management of parts as consumable articles or replaceable parts and generic management of printing status of col. 6 of Kageyama *may not be fairly considered to teach or suggest the claimed limitations of a threshold let alone setting the threshold as claimed.* Kageyama is void of any reference to “threshold”, a threshold for replenishment of a consumable or setting of the threshold.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and

Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument J

Claim 31 recites *providing the user-specified information from a user, and generating at least one of the configuration plug-in and configuration data using the user-specified information before the downloading.*

The Office failed to identify prior art teachings in the Office Action in support of the prior art rejection of claim 31. Now the Office relies upon the teachings of col. 5, line 66 and col. 6, line 11 and Fig. 10 of Kageyama as allegedly teaching the user-specified information. However, *the teachings of cols. 5 and 6 and Fig. 10 are void of any disclosure that the information of the database part 2121 is information which is specified by a user.* Appellants respectfully submit that the Office's interpretation that the database part 2121 contains user-specified information is not supported by the teachings of the prior art. Appellants respectfully submit the limitations of *providing the user-specified information from a user* is not disclosed or suggested by the prior art and the rejection is improper for at least this reason.

The Office also relies upon the teachings of col. 15, lines 33-39 of Kageyama in support of the rejection. These teachings clearly disclose communications of updating programs and data *from the printer manufacturer to the printer* and are void of any reference to *user-specified information*. The teachings relied upon by the Office fail to disclose or suggest *generating at least one of the configuration plug-in and configuration data using the user-specified information before the downloading.* Appellants respectfully submit the generating limitations are not disclosed or suggested by the prior art and the rejection is improper for at least this reason.

The Office baldly states at pages 24-25 of the Examiner's Answer that the data used to perform the updating of col. 15 of Kageyama is directly related to the user specified information. The Office has failed to identify any teachings in support of the statement and Appellants have failed to uncover any teachings that the contents of database part 2121 is downloaded.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and

Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Argument K

Claim 34 recites that the *processing circuitry is configured to employ the software module to set a threshold for replenishment of a consumable associated with the hard copy output engine to configure the hard copy output engine.*

Appellants have electronically searched failed to uncover any teachings in Kageyama or Engel of a threshold. Appellants respectfully submit that the prior art void of any reference to a threshold may not be fairly considered to teach or suggest the claimed limitations of setting the threshold for replenishment of a consumable and the rejection is in error for at least this reason.

The Office relies upon the teachings of cols. 5 and 6 of Kageyama as allegedly teaching the limitations of claim 34. However, the presence of use and operation information within a database of cols. 5 and 6 and generic teachings of management of parts as consumable articles or replaceable parts and generic management of printing status of col. 6 *may not be fairly considered to teach or suggest the claimed limitations of a threshold let alone processing circuitry is configured to employ the software module to set a threshold for replenishment of a consumable as claimed.* Kageyama is void of any reference to “threshold”, a threshold for replenishment of a consumable or setting the threshold. Furthermore, the Office has failed to provide any support for the position that the teachings of cols. 5-6 teach monitoring use information of monitoring a user’s device with respect to use information let alone monitoring a printer’s threshold value.


Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by the prior art references taken alone or in combination and Appellants respectfully request reversal of the prior art rejection of the claims for at least this reason and the reasons set forth in the Brief.

Conclusion

Reversal of the rejections of the claims and allowance of the claims is respectfully requested for at least the reasons discussed herein and the reasons set forth in the Brief of Appellant.

Respectfully submitted,

Date: 5/27/08

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